



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,024	11/12/2003	Wilton W. Webster JR.	51216/AW/W112	6209

23363 7590 06/09/2006

CHRISTIE, PARKER & HALE, LLP
PO BOX 7068
PASADENA, CA 91109-7068

EXAMINER

CAZAN, LIVIUS RADU

ART UNIT	PAPER NUMBER
----------	--------------

3729

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/706,024

Applicant(s)

WEBSTER ET AL.

Examiner

Livius R. Cazan

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/2/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

1. The disclosure is objected to because of the following informalities:

- On page 5, line 7, "hole14" should read --hole 14--
- On page 5, line 34, "FIG. 5" should read --FIG. 4--
- On page 6, line 15, "0,085" should read --0.085--
- On page 7, line 19, "FIG. 9" should read --FIG. 8--
- On page 7, line 24, "dies32" should read --dies 32--
- On page 7, line 32, "distal-" should read --distal--

Appropriate correction is required.

2. The use of the trademark MONEL has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrases "at least one lumen" (lines 3 and 4 of the claim) and "the lumen" (line 5) render the claim indefinite, since the phrase "at least one lumen" implies a plurality of lumens could be present, and in such an instance, it would be unclear to which lumen the phrase "the lumen" is directed.

The phrase "the portion ... that extends" (line 7) lacks proper antecedent basis and renders the claim indefinite, since, as claimed, it would appear the electrode lead wire is passed through the exit hole in its entirety; there is no mention of only a portion of the lead wire being passed through, so as to extend out of the exit hole.

The phrases "its diameter" (line 13) and "the diameter" (line 14) render the claim indefinite, since it is unclear whether an inner diameter or an outer diameter of the ring electrode is being discussed.

The term "about" in claim 1, line 15, claim 5, line 3, claim 6, line 3, and claim 9, line 3 is a relative term which renders the claim indefinite, since it is unclear what the degree of tolerance is, i.e. how closely the actual value (be it a temperature, an angle, or a diameter) must match the values specified in these claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, and 5-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Griffin (US6144870). Davies et al. ("The Rate Dependence of Confor Polyurethane Foams") is used as extrinsic evidence.

Griffin discloses a catheter tip comprising a tubular shaft with at least one lumen extending therethrough and a hole extending from the outer surface of the shaft to a corresponding lumen, such that an electrode lead wire is passed through a lumen and out through a hole, wherein the a portion of the electrode lead wire that extends out of the hole is wrapped around the shaft at least one full turn (see abstract; see Figs. 2-6). A ring electrode is slid along the shaft to a position directly over the wrapped wire, and thereafter it is compressed diametrically at one end so as to be fixed in place on the shaft, having a flared skirt shape (see col. 5, Ins. 1-6). The electrode is then swaged to reduce its diameter so as to secure it to the catheter tip and make contact with the lead, such that the inner diameter of the ring electrode is about the same as the outer diameter of the shaft and the outer surface of the lead wire is generally flush with the outer surface of the shaft (see col. 5, Ins. 6-15). The electrode lead wire is stripped of insulation at the portions extending out of the hole (col. 4, Ins. 30-40). The shaft is made of polyurethane (col. 3, Ins. 20-30) and may be heated to so as to soften the material of

Art Unit: 3729

the shaft (col. 4, Ins. 40-45). Note that although Griffin does not actually disclose the temperature at which the heating takes place, inherently a heating temperature must be applied which results in softening for the particular polyurethane used. Davies et al. disclose a polyurethane with a softening temperature of 90°C (underlined portion, page 118), so if such a polyurethane is used, clearly, it should be heated to about 90°C. Also note that the angle of flaring seen in Fig. 6 appears to be between about 4 degrees and about 8 degrees, and in particular about 6 degrees.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin as applied to claim 1 above.

a. Regarding claims 3 and 4, Griffin does not disclose wrapping the lead wire around the shaft at least two times nor using a clove hitch arrangement to secure the lead wire to the shaft.

At the time the invention was made, it would have been obvious matter of engineering design choice to a person of ordinary skill in the art to wrap the lead wire around the shaft more than once and to use a clove hitch arrangement because the Applicant admits that the particular arrangement is not essential, as long as the electrode lead wire is secured to the surface of the shaft (page 2, Ins.

25-35). Therefore, any wire arrangement that results in a secure connection will be adequate.

Therefore it would have been prima facie obvious to modify the invention of Griffin to obtain the invention as specified in claims 3 and 4 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Griffin.

b. Regarding claims 5 and 6, to the extent the applicant disagrees with the assertion that the flaring angle is between about 4 degrees and about 8 degrees, Griffin does not specifically discuss the flaring angle.

However, at the time the invention was made, it would have been obvious matter of engineering design choice to a person of ordinary skill in the art to form a flaring angle of between about 4 and about 8 degrees, in particular about 6 degrees, because, as discussed above (claim 1) and as seen in Fig. 5, the flared skirt is formed by pressing one end of the ring electrode so as to secure it to the shaft. As one of skill in the art would appreciate, since one end of the electrode is secured to the shaft, it does not matter what the flaring angle is, and it may easily be within the range specified by the Applicant.

Therefore it would have been prima facie obvious to modify Griffin to obtain the invention as specified in claims 5 and 6 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Griffin.

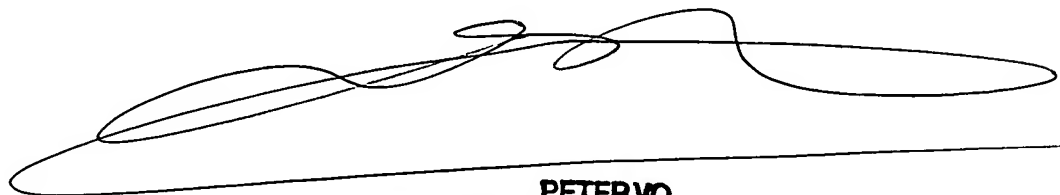
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Livius R. Cazan whose telephone number is (571) 272-8032. The examiner can normally be reached on 7:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571)272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LRC 06/05/2006



PETER VO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3729